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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/006,856	12/06/2001	Kevin' P. Baker	GNE:2830P1C14	8365	
9157 7590 01/24/2008 GENENTECH, INC. I DNA WAY SOUTH SAN FRANCISCO, CA 94080			EXAMINER		
			VOGEL, NANCY S		
			ART UNIT	PAPER NUMBER	
1			1636		
			MAIL DATE	DELIVERY MODE	
			01/24/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)				
	10/006,856	BAKER ET AL.				
Office Action Summary	Examiner	Art Unit				
	Nancy T. Vogel	1636	Ξ.			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DATE of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period we failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be time vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	I. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 04 Oc	ctober 2007.					
2a) This action is FINAL . 2b) ⊠ This	action is non-final.					
3) Since this application is in condition for allowar	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4)⊠ Claim(s) 28-35 and 38-47 is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>28-35 and 38-47</u> is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) are subject to restriction and/or election requirement.						
Application Papers						
9) The specification is objected to by the Examine	r.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
•	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Ex						
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
1. Certified copies of the priority documents	s have been received.					
_ , , , ,		on No				
 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage 						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attach mag mat(a)						
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ate				
3) Information Disclosure Statement(s) (PTO/SB/08)	5) Notice of Informal P					
Paper No(s)/Mail Date 6) Other: <u>sequence alignment</u> .						

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/4/07 has been entered.

The rejection of claims 28-35, 38-40 are no longer included in the rejection under 35 USC 101 and associated 112 first paragraph, since the utility for the polypeptide, i.e. as a stimulator of uptake of glucose or FFA in adipocytes, is accepted.

Claim Rejections - 35 USC § 101

Claims 41-47 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility.

Claims 41-47 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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This is a new rejection, based upon several new references which are cited for support, and based upon new reasoning. Specifically, the examiner no longer asserts that mRNA levels are not predictive of polypeptide levels. Therefore, the following references are no longer being relied upon to support the rejections: Chen et al., Hu et al., Haynes et al., Lian et al., Fessler et al., Nagaraja et al., Waghray et al., Sagnaliev et al., Lilley et al., Wildsmith et al., King et al., Celis et al., and Madoz-Gurpide et al. The following references cited and discussed by Applicant pertaining to the mRNA/polypeptide correlation issue will no longer be addressed: Futcher et al., Alberts and Lewin, Meric et al., Zhigang et al., Wang et al., Munaut et al. The basis of the maintained rejections is solely that gene amplification levels are not predictive of mRNA or polypeptide levels.

The claims are directed to the polypeptide of SEQ ID NO: 194 and variants thereof. The specification discloses the polypeptide of SEQ ID NO: 194, also known as PRO1303. The claims recite that the polypeptides are encoded by nucleic acid that is amplified in lung and colon tumors. In the specification, a gene amplification assay in which genomic DNA encoding PRO1303 had a Ct value of at least 1.0 for At pages 539-555 of the specification, Example 170 discloses a gene amplification assay in which genomic DNA encoding PRO1112 had a ACt value of at least 1.0 for 5 lung or colon tumor samples when compared to a pooled control of blood DNA from several healthy volunteers. Example 143 asserts that gene amplification is associated with overexpression of the gene product (i.e., the polypeptide), indicating that the polypeptides are useful targets for therapeutic intervention in cancer and diagnostic

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determination of the presence of cancer. A delta Ct is defined as the threshold PCR cycle, or the cycle at which the reporter signal accumulates above the background level of fluorescence. The specification further indicates that delta Ct is used as a quantitative measurement of the relative number of starting copies of a particular target sequence in a nucleic acid sample when comparing cancer DNA results to normal human DNA results. It is noted that at page 507, it is stated that samples are used if their values are within 1 Ct of the 'normal standard'. It is further noted that the ACt values are expressed with values to one one-hundredth of a unit (e.g. 1.29).

First, there are several problems with the data provided in this example. The art recognizes that lung and colon epithelium is can be aneuploid without the presence of cancer. Specifically, Hittelman (2001, Ann. N. Y. Acad. Sci. 952:1-12) reports that lung epithelium is at risk for cellular damage due to direct exposure to environmental pollutants and carcinogens, which result in aneuploidy before the epithelial cells turn cancerous. See especially p. 4, Figure 4. The gene amplification assay in the instant specification does not provide a comparison between the lung tumor samples and normal lung epithelium and does not correct for aneuploidy. Thus it is not clear that PRO1112 is amplified in cancerous lung epithelium more than in damaged (non\cancerous) lung epithelium. One skilled in the art would not conclude that PRO1303 is a diagnostic probe for lung cancer unless it is clear that PRO1303 is amplified to a clearly greater extent in true lung tumor tissue relative to non-cancerous lung epithelium. Regarding colon tissue, pre-malignant lesions and ulcerative colitis have been associated with aneuploidy. See Fleischhacker et al. (1995, Modern Pathology

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8:360-365), especially p. 360, 1st paragraph of introduction. The gene amplification assay in the instant specification does not provide a comparison between the colon tumor samples and normal colon epithelium and does not correct for aneuploidy. Thus it is not clear that PRO1303 is amplified in cancerous colon epithelium more than in damaged (non-cancerous) colon epithelium. One skilled in the art would not conclude that PRO1303 is a diagnostic probe for colon cancer unless it is clear that PRO1303 is amplified to a clearly greater extent in true colon tumor tissue relative to non-cancerous colon epithelium.

Second, even if the data had been corrected for aneuploidy and a proper control had been used, the data have no bearing on the utility of the claimed PRO1303 polypeptide. In order for PRO1303 polypeptide to be overexpressed in tumors, amplified genomic DNA would have to correlate with increased mRNA levels and increased polypeptide levels. No data regarding PRO1303 mRNA or PRO1303 polypeptide levels in lung or colon tumors have been brought forth on the record. The art discloses that a correlation between genomic DNA levels and mRNA levels cannot be presumed, nor can any correlation between genomic DNA levels and polypeptide levels. A specific example of the lack of correlation between genomic DNA amplification and increased mRNA expression is provided by Pennica et al. (1998, PNAS USA 95:14717-14722), who disclose that: "An analysis of WISP-1 gene amplification and expression in human colon tumors showed a correlation between DNA amplification and overexpression, whereas overexpression of WISP-3 RNA was seen in the absence of DNA amplification. In contrast, WISP-2 DNA was amplified in the colon tumors, but its

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mRNA expression was significantly reduced in the majority of tumors compared with the expression in normal colonic mucosa from the same patient.'

See p. 14722, second paragraph of left column; pp. 14720-14721, "Amplification and Aberrant Expression of WISPs in Human Colon Tumors." Another specific example is provided by Konopka et al. (Proc. Natl. Acad. Sci. (1986) 83:4049-4052), who state that "Protein expression is not related to amplification of the abl gene but to variation in the level of bcr-abl mRNA produced from a single Phl template" (see abstract). The general concept of gene amplification's lack of correlation with mRNA/protein overexpression in cancer tissue is addressed by Sen (2000, Curr. Opin. Oncol. 12:82-88). Specifically, Sen teaches that cancerous tissue is known to be aneuploid, that is, having an abnormal number of chromosomes. A slight amplification of a gene does not necessarily correlate with overexpression in a cancer tissue, but can merely be an indication that the cancer tissue is aneuploid. Hittelman (2001, Ann. N. Y. Acad. Sci. 952:1-12) also speaks to this issue. Again, the data in the specification were. not corrected for such aneuploidy events. Furthermore, Godbout et al. (1998, J. Biol. Chem. 273(33):21161-8) teach a general lack of correlation between gene amplification and mRNA/protein overexpression. The abstract of Godbout teaches "The DEAD box gene, DDXI, is a putative RNA helicase that is co-amplified with MYCN in a subset of retinoblastoma (RB) and neuroblastoma (NB) tumors and cell lines. Although gene amplification usually involves hundreds to thousands of kilobase pairs of DNA, a number of studies suggest that co-amplified genes are only overexpressed if they provide a selective advantage to the cells in which they are amplified." (emphasis

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added). The protein encoded by the DDX gone had been characterized as being a putative RNA helicase, a type of enzyme that would be expected to confer a selective advantage to the cells in which it (the DDX gone) was amplified. On page 21167, right column, first full paragraph, Godbout et al. state "It is generally accepted that coamplified genes are not over-expressed unless they provide a selective growth advantage to the cell (48, 49). For example, although ERBA is closely linked to ERBB2 in breast cancer and both genes are commonly amplified in these tumors, ERBA is not overexpressed (48). Similarly, three genes mapping to 12q13-14 (CDK4, SAS and MDM2) are overexpressed in a high percentage of malignant gliomas showing amplification of this chromosomal region, while other genes mapping to this region (GADD153, GL1, and A2MR) are rarely overexpressed in gone-amplified malignant gliomas (50, 51). The first three genes are probably the main targets of the amplification process, while the latter three genes are probably incidentally included in the amplicons." (emphasis added). There is no evidence in the instant application that PRO1303 confers any growth advantage to a cell, and thus it cannot be presumed that the protein is overexpressed because the genomic DNA including the gone being studied gone is amplified.

An additional reference that provides evidence that gone amplification does not generally lead to increased transcript is Li et al. (2006; Oncogene, Vol. 25, pages 2628-2635). Li et al. used a functional approach that integrated simultaneous genomic and transcript microarray, proteomics, and tissue microarray analyses to directly identify putative oncogenes in lung adenocarcinoma. On page 2633, right column, Li et al. state:

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"In our study, 68.8% of the genes showing over-representation in the genome did not show elevated transcript levels, implying that at least some of these genes are 'passenger' genes that are concurrently amplified because of their location with respect to amplicons but lack biological relevance in terms of the development of lung adenocarcinoma." Since more than half of the amplified genes were not overexpressed, Li et al. constitutes strong evidence that it is more likely than not that gene amplification does NOT correlate with increased protein levels, absent evidence that the protein has biological relevance in cancer. There is no such evidence for PRO1303.. The data do not support the specification's assertion that PRO1303 polypeptides and their antibodies can be used as cancer diagnostic agents. Significant further research would have been required of the skilled artisan to reasonably confirm that the PRO1303 polypeptide is overexpressed in any cancer to the extent that the polypeptide or antibodies that bind it could be used as cancer diagnostic agents, and thus the asserted utility is not substantial. In the absence of information regarding whether or not PRO1112 polypeptide levels are also different between specific cancerous and normal tissues, the proposed use of the PRO1303 polypeptides as diagnostic markers and therapeutic targets are simply starting points for further research and investigation into potential practical uses of the polypeptides and antibodies. See Brenner v. Manson, 148 U.S.P.Q. 689 (Sup. Ct., 1966), wherein the court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific

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benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

In view of the preponderance of evidence supporting the rejections (Pennica et al., Konopka et al., Fleischhacker et al., Sen, Hittelman, Godbout et al., and Li et al)., the rejections are properly maintained.

The Declaration of Dr. Randy Scott, and Dr. Paul Polakis under 37 CFR 1.132 filed 10/4/07 is insufficient to overcome the rejection of claims 41-47 based upon 35 USC 101/112 first paragraph as set forth in the last Office action because: the current rejection is based upon the gene amplification as a utility. It is not longer being maintained that mRNA levels are not predictive of polypeptide levels.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-32, 39-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

This rejection is maintained for reasons of record.

Applicants have argued that the claims do not recite any variant, but only those in which the nucleic acid encoding the polypeptide is amplified in lung or colon tumor cells. (It is noted that claims are included that recite the activity of stimulation of uptake of glucose or FFA). Applicants have argued that this is a legitimate functional limitation, and that a functional limitation is an attempt to define something by what it does, rather than by what it is. However, the characteristic of being encoded by a gene which is amplified in certain tissues, is not a description of what the protein does. Furthermore, it is maintained that the recitation of the polypeptide variants having as little as 80-85% Homology to the disclosed protein, and having a particular function, does not adequately provide guidance for one of ordinary skill in the art to discover which of the proteins encompassed has the claimed activity. Therefore, the rejection is maintained.

Claims 28-32 and 39-47 are rejected under 35 U.S.C. 1 12, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is maintained essentially for the reasons set forth in the previous Office action, mailed 4/10/07.

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Applicants have argued that they maintain the position set forth in the previous responses and the Appeal Brief. For the reasons set forth in the previous Office action, the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 28-35, 38, 41-45 are rejected under 35 U.S.C. 102(a) as being anticipated by Youseff et al. (Anticancer Research, 19:2843-2852 (1999)).

Youseff et al. disclose an isolated polypeptide having 100% homology to the protein whose sequence is shown in SEQ ID NO:194 (see attached alignment).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy T. Vogel whose telephone number is (571) 272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NV

12/20/07

NANCY VOGEL
PRIMARY EXAMINER

ALIGNMENTS

```
RESULT 1
KLKC HUMAN
     KLKC HUMAN
                    STANDARD; PRT;
                                           248 AA.
ID
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AC
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DT
     16-OCT-2001 (Rel. 40, Last sequence update)
DT
     16-OCT-2001 (Rel. 40, Last annotation update)
\operatorname{DT}
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DE
protein 5)
    (KLK-L5).
DE
     KLK12 OR KLKL5.
GN
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OC
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RP
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RX
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RA
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chromosome
     19q13.3-q13.4.";
RT
     Anticancer Res. 19:2843-2852(1999).
RL
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RN
     SEQUENCE FROM N.A. (ISOFORMS 1 AND 2).
RP
     Yousef G.M., Magklara A., Scorilas A., Diamandis E.P.;
     "Cloning of new alternatively spliced forms of the
RT
kallikrein-like
     gene 5 (KLK-L5).";
RT
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RL
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RN
     SEQUENCE FROM N.A. (ISOFORM 1).
RP
     MEDLINE=20510030; PubMed=11054574;
RX
     Gan L., Lee I., Smith R., Argonza-Barrett R., Lei H., McCuaig
RA
J.,
     Moss P., Paeper B., Wang K.;
RA
     "Sequencing and expression analysis of the serine protease
RT
gene
     cluster located in chromosome 19q13 region.";
RT
     Gene 257:119-130(2000).
RL
     [4]
RN
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SEQUENCE FROM N.A. (ISOFORM 2).
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    Lamerdin J.E., McCready P.M., Skowronski E., Viswanathan V.,
RA
    Burkhart-Schultz K., Gordon L., Dias J., Ramirez M.,
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Stilwagen S.,
    Phan H., Velasco N., Do L., Regala W., Terry A., Brower A.,
RA
Garnes J.,
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RA
J., Liu S.,
    Andreise T., Trankheim M., Attix C., Amico-Keller G.,
RA
Coefield J.,
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RA
B.,
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A.,
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CC
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CC
subfamily.
CC
     This SWISS-PROT entry is copyright. It is produced through a
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    the European Bioinformatics Institute. There are no
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http://www.isb-sib.ch/announce/
     or send an email to license@isb-sib.ch).
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\operatorname{FT}
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Best Local Similarity 100.0%; Pred. No. 7.9e-255;
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0; Gaps
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Qу
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Db
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DT
    15-DEC-1998 (Rel. 37, Last sequence update)
DT
    15-MAR-2004 (Rel. 43, Last annotation update)
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DE
activator)
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